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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------------|
| 10/520,401 | 09/12/2005 | Irene Bozzoni | 2520-1050 | 2717 |
| 465 7590 09/29/2008 YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314 | | | EXAMINER RAMIREZ, DELIA M | |
| | | | ART UNIT 1652 | PAPER NUMBER |
| | | | MAIL DATE 09/29/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of Allowability**Application No.**

10/520,401

Applicant(s)

BOZZONI ET AL.

Examiner

DELIA M. RAMIREZ

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to see attached.
2. ☒ The allowed claim(s) is/are 19-21 and 35.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date ____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date ____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other ____.

DETAILED ACTION

Status of the Application

Claims 19-21 and 35 have been allowed as indicated in the Notice of Allowance (PTO-37) mailed on 9/19/2008.

This supplemental Examiner's amendment is necessary in view of a typographical error shown in the previous Examiner's amendment mailed with the Notice of Allowance on 9/19/2008. Specifically, the Examiner's amendment should have cancelled claims 18 and 36 and not claims 18 and 35 as previously indicated. An additional typographical error was made in the Reasons for Allowance previously submitted. The previous action states on page 3 that the previous 35 USC 102(b) and 103(a) rejections applied to claims 1-21 and 35 are being withdrawn. The action should have stated that the art rejections applied to claims 19-21 and 35 are withdrawn.

Examiner's Amendment

1. This application is in condition for allowance except for the presence of claims 18, 36 directed to an invention non-elected without traverse. Accordingly, claims 18, 36 have been cancelled.
2. Please cancel non-elected claims 18 and 36.

Reasons for Allowance

The following is an Examiner's statement of reasons for allowance. In previous Office actions, the Examiner has indicated that the polynucleotide of SEQ ID NO: 1 as originally presented in Figure 4 (1268 nucleotides) was deemed unpatentable under 35 USC 102(b) in view of the teachings of Pietro Laneve (Purificazione e caratterizzazione di una nuova attivita endoribonucleolitica coinvolta nella biosintesi dei piccolo RNA nucleolari in *X. laevis*, Thesis, 2001; cited in the IDS) as evidenced by GenBank accession number AJ507315 (cited in the IDS). SEQ ID NO: 1 as shown in Figure 4 as

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originally filed is identical to the sequence disclosed in the Laneve thesis. Applicant traversed this rejection in the response filed on 5/8/2008 by indicating that the Laneve thesis could not be considered proper prior art because the thesis was presented at a University in Italy and that the invention was not patented or described in a printed publication in this country or foreign country, or in public use or on sale in this country, more than a year prior to the date of the application for patent in the United States. Since the Examiner could not find any evidence of record which would lead one to reasonably conclude that the Laneve thesis was not publicly available in 2001, two years prior to the filing date of the international application from which the instant application derives, a request under 37 CFR 1.105 was made in the action mailed on 6/3/2008 to clarify the issue of public availability of the Laneve thesis. In response to this request, Applicant has filed on 8/11/2008 a declaration by Professor Sergio Pimpinelli, Director of the Department of Genetics and Molecular Biology, University of Rome "La Sapienza", indicating that the Laneve thesis was orally discussed in 2001 and was never placed in a library or bookshelf or any place for public browsing. In view of this signed declaration, the previous 35 USC 102(b) and 103(a) rejections applied to claims 19-21 and 35 are hereby withdrawn.

Conclusion

3. Claims 19-21 and 35 are allowed.
4. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Nashaat Nashed can be reached on (571) 272-0934. Any

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inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

/Delia M. Ramirez/

Delia M. Ramirez, Ph.D.
Primary Patent Examiner
Art Unit 1652

DR
September 26, 2008